

FORM PTO -1083
MAIL STOP: AMENDMENT
COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450



Docket No.: 900.1009US
Date: August 18, 2005

In re application of: Wei CHEN, et al
Serial No.: 10/821,473
Filed: April 8, 2004
For: PREPARATION AND PURIFICATION OF SYNTHETIC CAPSAICIN

Sir:

Transmitted herewith is an **Information Disclosure Statement** in the above-identified application.

- ☒ Small entity status of this application under 37 C.F.R. 1.9 and 1.27 has been established.
☐ A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.
☒ No fee for additional claims is required.
☐ A filing fee for additional claims calculated as shown below, is required:

(Col. 1)		(Col. 2)		SMALL ENTITY			LARGE ENTITY		
FOR:	REMAINING	HIGHEST		RATE	FEE	OR	RATE	FEE	
	AFTER	PREVIOUSLY	PRESENT						
	AMENDMENT	PAID FOR	EXTRA						
TOTAL CLAIMS	*	Minus 20**	=	x \$ 9	\$		x \$ 18	\$	
INDEP. CLAIMS	*	Minus 3***	=	x \$ 43	\$		x \$ 86	\$	
[] FIRST PRESENTATION OF MULTIPLE DEP. CLAIM				+	\$145	\$	+	\$290	\$
TOTAL: \$				OR			TOTAL: \$0.00		

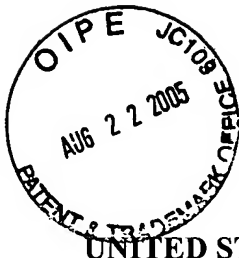
- * If the entry in Co. 1 is less than the entry in Col. 2, write "0" in Col. 3.
** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, write "20" in this space.
*** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, write "3" in this space.

- ☒ Also transmitted herewith are:
☒ Form PTO 1449 (2 pages); and
☒ copies of references cited
- ☐ Check(s) in the amount of \$0.00 is/are attached to cover:
☐ Filing fee for additional claims under 37 C.F.R. 1.16
☐ Petition fee
☐ Other:
☐ Other:
- ☒ The Assistant Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 50-0552.
☐ Any filing fee under 37 C.F.R. 1.16 for the presentation of additional claims which are not paid by check submitted herewith.
☒ Any patent application processing fees under 37 C.F.R. 1.17.
☒ Any petition fees for extension under 37 C.F.R. 1.136 which are not paid by check submitted herewith, and it is hereby requested that this be a petition for an automatic extension of time under 37 CFR 1.136.

Richard V. Zanzalari, Reg. No. 49,032
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I hereby certify that this correspondence and/or documents referred to as attached therein and/or fee are being deposited with the United States Postal Service as "first class mail" in an envelope addressed to Mail Stop: Amendment "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450", on August 18, 2005.

BY:
Elizabeth Pietrowski



900.1009

UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner: Sabiha Naim QAZI, Art Unit: 1614
Re: Application of: Wei CHEN et al.
 Serial No.: 10/821,473
 Filed: April 8, 2004
 For: **PREPARATION AND PURIFICATION OF
SYNTHETIC CAPSAICIN**

INFORMATION DISCLOSURE
STATEMENT UNDER 37 C.F.R. § 1.56

Mail Stop: Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

August 18, 2005

Sir:

In accordance with the provisions of 37 C.F.R. § 1.97, Applicants hereby make of record the documents listed on the accompanying Form PTO-1449 (2 sheets) for consideration by the Examiner in connection with the examination of the above-identified patent application.

Pursuant to 37 C.F.R. § 1.98 (a), the foreign patent and non-patent references listed on the attached Form PTO-1449 are enclosed. If it is determined that any of the listed references are not presently enclosed, the Examiner is requested to contact the undersigned so that a copy can be forwarded.

Applicants also respectfully advise the Examiner of the following co-pending U.S. Patent Applications which are commonly assigned to the owners of the instant application:

U.S. Application Serial No. 10/742,441, entitled "Injectable Capsaicin With Non-Steroidal Anti-Inflammatory Agent Adjunctive Agent", filed December 18, 2003, published as US 2004/0161481 A1, listed as reference "BB" on the attached Form PTO-1449;

U.S. Application Serial No. 10/742,621, entitled "Injectable Capsaicin", filed December 18, 2003, published as US 2005/0019436 A1, listed as reference "BC" on the attached Form PTO-1449;

U.S. Application Serial No. 10/741,197, entitled "Injectable Capsaicin With Non-Local Anesthetic Sodium Channel-Blocker Adjunctive Agent", filed December 18, 2003, published as US 2004/0186182 A1, listed as reference "BD" on the attached Form PTO-1449;

U.S. Application Serial No. 10/741,196, entitled "Injectable Capsaicin With Vasoconstrictor Adjunctive Agent", filed December 18, 2003, published as US 2004/0058734 A1, listed as reference "BE" on the attached Form PTO-1449;

U.S. Application Serial No. 10/741,194, entitled "Injectable Capsaicin With Tricyclic Antidepressant Adjunctive Agent", filed December 18, 2003, published as US 2004/0191338 A1, listed as reference "BF" on the attached Form PTO-1449;

U.S. Application Serial No. 10/742,443, entitled "Injectable Capsaicin With Nitrate Vasodilator Adjunctive Agent", filed December 18, 2003, published as US 2004/0156931 A1, listed as reference "BG" on the attached Form PTO-1449; and

U.S. Application Serial No. 10/741,195, entitled "Infiltration of Capsaicin Into Surgical Sites and Open Wounds", filed December 18, 2004, published as US 2005/0020690 A1, listed as reference "BH" on the attached Form PTO-1449.

It is respectfully requested that the references cited in the accompanying Form PTO-1449 (2 sheets) be considered and made of record.

This Information Disclosure Statement is filed under 37 C.F.R. § 1.97 (b), before the mailing of a first Office Action. Accordingly, no fee is believed due. In the event any fee is due in connection with the filing of this Information Disclosure Statement, the Commissioner is hereby authorized to charge said deficiency or credit overpayment to our Deposit Account No. 50-0552.

Respectfully submitted,
DAVIDSON, DAVIDSON & KAPPEL, LLC

By Richard V. Zanzalari
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FORM PTO-1449
(REV. 7-80)U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICEATTY. DOCKET NO.:
900.1009USSERIAL NO.:
10/821,473

LIST OF PRIOR ART CITED BY APPLICANT

(Use several sheets if necessary)

APPLICANT(S):
Chen et al.FILING DATE:
April 8, 2004GROUP:
1614

U.S. PATENT DOCUMENTS

*EXAMINER INITIAL		DOCUMENT NUMBER								DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
	AA	4	3	1	3	9	5	8		02/02/1982	LaHann	514	627	
	AB	4	4	2	4	2	0	5		01/03/1984	LaHann	8	161	
	AC	4	4	9	3	8	4	8		01/15/1985	LaHann et al.	514	627	
	AD	4	2	3	2	1	3	9		11/04/1980	Minami et al.	526	125.6	
	AE	4	5	4	4	6	6	8		10/01/1985	Janusz et al.	514	563	
	AF	4	5	4	4	6	6	9		10/01/1985	LaHann et al.	514	563	
	AG	4	8	1	2	4	4	6		03/14/1989	Brand	514	165	

FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER								DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION	
														YES	NO
	AH	0	0	6	8	5	9	0		01/02/1985	EP(B1)	C07C	127/17		
	AI	0	0	6	8	5	9	1		09/25/1985	EP(B1)	C07C	143/822		
	AJ	0	0	6	8	5	9	2		10/17/1984	EP(B1)	C07C	125/065		
	AK	0	0	8	9	7	1	0		07/31/1985	EP(B1)	C07C	103/76		
	AL	0	1	4	9	5	4	5		12/27/1989	EP(B1)	A61K	31/615		

OTHER PRIOR ART (Including Author, Title, Date, Pertinent Pages, Etc.)

AM	Adolf, W., et al., "Structure-activity relations of polyfunctional diterpenes of the daphane type I revised structure for resiniferatoxin and structure-activity relations of resiniferonol and some of its esters", <i>J of Natural Products</i> Vol 45 No 3(1982) pp 347-357
AN	Bennett, D.J., et al., "Constitution and Biosynthesis of Capsaicin", <i>J Chem Soc C</i> (1968) pp 442-446
AO	Cassy, J., et al., "A one step synthesis of ω -hydroxyacetylenic carboxylic acids" <i>Tetrahedron</i> Vol 27 No 5 (1986) pp 573-574
AP	Crombie, L., et al., "Synthesis of capsaicin", <i>Amides of Vegetable Origin Part VI</i> (1955) pp 1025-1027
AQ	Gannett, P.M., et al., "The capsaicinoids: Their separation, synthesis and mutagenicity", <i>J Org Chem</i> Vol 53 (1988) pp 1064-1071
AR	Gannett, P.M., et al., "The capsaicinoids: Their separation, synthesis and mutagenicity" Additions and Corrections <i>J Org Chem</i> Vol 53 No 26 (1988) p 6162
AS	Hiroo et al., "An essay on the synthesis of capsaicin analogs", <i>Kogyo</i> No 129 (1980) pp 41-46

EXAMINER

DATE CONSIDERED

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

FORM PTO-1449
(REV. 7-80)U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICEATTY. DOCKET NO.:
900.1009USSERIAL NO.:
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LIST OF PRIOR ART CITED BY APPLICANT

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1614

U.S. PATENT DOCUMENTS

*EXAMINER INITIAL		DOCUMENT NUMBER								DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
	BA	5	0	9	4	7	8	2		03/10/1992	Chen et al.	554	63	
	BB	20	04	01	61	4	8	1		08/19/2004	Burch et al.	424	760	12/18/2003
	BC	20	05	00	19	4	3	6		01/27/2005	Burch et al.	424	760	12/18/2003
	BD	20	04	01	86	1	8	2		09/23/2004	Burch et al.	514	625	12/18/2003
	BE	20	05	00	58	7	3	4		03/17/2005	Burch et al.	424	760	12/18/2003
	BF	20	04	01	91	3	3	8		09/30/2004	Burch et al.	424	760	12/18/2003
	BG	20	04	01	56	9	3	1		08/12/2004	Burch et al.	424	760	12/18/2003
	BH	20	05	00	20	6	9	0		01/27/2005	Burch et al.	514	625	12/18/2003

FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER								DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION	
														YES	NO
	BI	6	0	0	9	3	0	8		01/18/1994	JP	A01N	37/18	abstract	

OTHER PRIOR ART (Including Author, Title, Date, Pertinent Pages, Etc.)

	BJ	House, H.O., et al., "Reactions involving electron transfer v. reduction of nonconjugated acetylenes", <i>J Org Chem</i> Vol 39 No 6 (1974) pp 747-755												
	BK	Junusz, J.M., et al., "Vanilloids. 1. Analogs of capsaicin with antinociceptive and antiinflammatory activity", <i>J Med Chem</i> Vol 36 (1993) pp 2595-2604												
	BL	Jezo, I., "Synthese des capsaicins und eingiger seiner modellderivate", <i>Chem Zvesti</i> Vol 29(5) (1975) pp 714-718												
	BM	Kaga, H., et al., "A general and stereoselective synthesis of the capsaicinoids via the orthoester claisen rearrangement", <i>Tetrahedron</i> Vol 52 No 25 (1996) pp 8451-8470												
	BN	Kaga, H., et al., "A Facile procedure for synthesis of capsaicin", <i>J Org Chem</i> Vol 54 No 14 (1989) pp 3477-3478												
	BO	<i>Khim.-Farm Zh</i> Vol 30 No 1 (1996) pp 54-61												
	BP	Thresh, J.C., "Capsaicin, the active principle of capsicum fruits", <i>Pharm Journ</i> Third Series, No 315 (1876) p 21												
	BQ	Vig, O.P., et al., "A new synthesis of N-(4'-hydroxy-3'-methoxybenzyl)-8-methyl-non-6(E)-enamide (Capsaicin)", <i>Indian J Chem</i> Vol 17B (1979) pp 558-559												
	BR	Walker, G.T., "Capsaicin: properties, reactions and uses" <i>Manufact Chemist and Aerosol News</i> (June 1968) pp 35-36												
	BS													

EXAMINER

DATE CONSIDERED

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.